

### **REMARKS**

The present response is to the Office Action mailed in the above-referenced case on May 20, 2005. Claims 1-18 are pending in the application. The Examiner objects to the drawings as failing to comply with 37 CFR 1.84(p)(5). The specification is objected to because of informalities. Claims 5 and 17 are rejected under 35 U.S.C. 112, second paragraph. Claims 1, 2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Zuckerman et al. (WO Patent 95/34609) hereinafter Zuckerman. Claims 1, 2, 4, 8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricken (US Patent No. 4,974,397) hereinafter Ricken in view of Bryant et al. (US Patent No. 5,366,801) hereinafter Bryant. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ricken in view of Bryant, and further in view of Pushaw (US Patent No. 5,677,048) hereinafter Pushaw. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricken in view of Bryant and further in view of Pause (US Patent No. 6,217,993) hereinafter Pause. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ricken in view of Bryant and further in view of Schortmann (US Patent No. 4,499,139) hereinafter Schortmann. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricken in view of Bryant and further in view of Woods (US Patent No. 5,802,823) hereinafter Woods. Finally, claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ricken in view of Bryant and further in view of Widdemer (US Patent Application No. 2002/0035755).

In response to the Examiner's rejections and statements, applicant herein amends the specification, correcting the disclosure and providing marked-up copies of figures from the as-filed case with proposed drawing corrections for the Examiner's consideration. The claims are amended to overcome the 112 rejection and to more particularly recite subject matter deemed patentable by the inventor. The applicant states for the record that the amendments made are to recite specifically one embodiment of the invention, and intends no admission by the additional limitation of applicable prior art or agreement with the Examiner's action or remarks.

Claim 1 is specifically amended to positively recite that the composite material has 4 individual layers of material wherein a phase change material (PCM) is joined to the padding material on a side opposite the side contacting the animal's flesh.

The Examiner rejected claim 1 under 35 U.S.C. 102(b) as being anticipated by Zuckerman. In view of the amended form of claim 1, applicant believes that the rejection no longer applies. Basically, Zuckerman teaches the existence of PCM material and claim 1 now includes a composite material with a plurality of specific layers.

Claim 1 is rejected by the Examiner as being obvious over Ricken in view of Bryant. Ricken teaches a saddle pad made of multiple layers of material for absorbing shock from the rider to the horse. Bryant teaches PCM material for use on individuals and machinery.

Applicant's claim 1, as amended now recites; one bottom layer of natural padding material having direct contact with the animal's flesh; one second layer of anti-bacterial batting material above and adjacent to the padding material; one third layer of shock-absorbing material above and adjacent to the anti-bacterial batting; and one top layer of high friction non-skid material above and adjacent to the third layer; wherein a phase change material (PCM) is joined to the padding material on the side opposite the side contacting the animal's flesh.

Applicant argues that Ricken teaches one layer of felt, a layer of visco-elastic poly-mere material, one layer of Polyurethane foam (open celled) and another layer of felt. Applicant believes the positively recited specific layers of claim 1, as amended overcome the limited teaching of Ricken's 4 layer pad.

The Examiner states that Ricken is silent with respect to teaching that a phase change material is joined to one of the layers of padding material; padding material is one of the other of woven or non-woven material. The Examiner states that Bryant teaches the PCM. The Examiner further states a skilled artisan would have found it obvious to use phase change material disclosed in the invention of Bryant et al. and used it in the felt disclosed in the invention of Ricken. One would be motivated to do this in order to provide a saddle pad with enhanced thermal properties so that it can effectively maintain the comfortable skin temperature of horse.

Applicant argues that Examiner attempts to equate the material used in Ricken's saddle pad with the specific layers claimed in applicant's claim 1. The Examiner provides other various pieces of art in order to teach the other layers of applicant's composite material. Applicant argues that merely providing references proving the existence of certain materials is not enough. There must be some motivation or suggestion in the art to make the inventive combination and application claimed by the inventor of the present application.

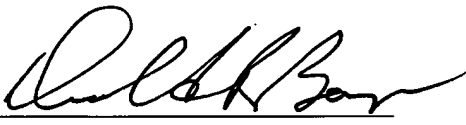
Applicant further argues that in order to establish a prima fade case of obviousness, three basic criteria must be met.” MPEP §706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The law regarding obviousness is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

Applicant argues that Ricken makes no suggestion, nor provides a motive for stabilizing temperature in a saddle pad. Further, Bryant makes no suggestion, nor provides any motivation for using the PCM in the application of a multi-layer saddle pad for an animal. Bryant specifically states that the PCM material is for human and mechanical applications. Further the other references provided by the Examiner make no suggestion to use the material taught in the application of the present invention.

Therefore, applicant believes the art fails and claim 1 is clearly patentable over the art. Claims 2-5, 7, 11, 13, and 14-18 are patentable on their own merits, or at least a depended from a patentable claim.

In view of applicant's amended claims, the Examiner's present rejections are moot. As all of the claims standing for examination are novel and clearly patentable over the art of record, applicant respectfully requests reconsideration, and that the present case be passed quickly to issue. If there are any time extensions needed beyond any extension specifically requested with this response, such extension of time is hereby requested. If there are any fees due beyond any fees paid with this amendment, authorization is given to deduct such fees from deposit account 50-0534.

Respectfully Submitted,  
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